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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,434	11/02/2000	Yuichi Yamagami	2271/62705	4780

7590 03/15/2006

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/704,434	Applicant(s) YAMAGAMI ET AL.	
	Examiner Jamisue A. Webb	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2005 and 12 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Claims 1-13 and 17 in the reply filed on 12/12/05 is acknowledged. The traversal is on the ground(s) that the inventions are not independent because the both are interrelated due to the fact that they both are related to the calculation of shipping charger, and that search for one invention would result in the search for the other invention. This is not found persuasive because Although they may be related to the same general subject matter, does not necessarily mean they are interrelated. The restriction states that the claims are independent and distinct if it can be shown that they have different modes of operation, different functions or different effects. Invention I is a method for managing shipping charges using actual and virtual locations. Invention II has a different mode of operation by use of a system which tracks shipping charges and don't mention anything about a virtual location. Furthermore, the inventions are patentably distinct, meaning one can infringe on one Invention without infringing on the other invention. Even though they are related to the same subject matter, they would require different searches due to the fact that each of the inventions disclose different claimed features.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3.

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4. Claims 1-13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: steps, which utilize the computed difference to manage the shipping charges. The claims are drawn to a method of managing shipping charges and discloses utilizing a difference between the first and second charges, however it is unclear how the differences are utilized, and how the shipping charges are managed. What steps are actually involved in the management of the charges? The only thing claimed is a description of the charges, but not how to manage them.

6. Claim 13 recites the limitation "the set of steps of fulfilling" in line 1. There is insufficient antecedent basis for this limitation in the claim.

7. With respect to Claim 13: the phrase "carrying out the set of steps of fulfilling through computing a second shipping charge for orders" is indefinite. The steps related to fulfilling are physical steps, which fulfill orders, and packages items, it is unclear how these steps can be performed by computing a shipping charge. How does computing a shipping charge cause a package to be wrapped and ready for shipment?

8. With respect to Claim 13: the phrase "said steps of computing a difference and utilizing the difference comprise computing differences related to a number of said time period and utilizing at least some of said differences", is indefinite. It is unclear to the examiner what this phrase is attempting to claim. It claims utilizing at least some of said differences, yet it does not

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disclose how they are utilized. It is unclear to the examiner what “related to a number of said time period” is referring to, are the differences calculated according to a certain time period?

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6, 8-13, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Arumapuram et al. (US 2002/0019759).

11. With respect to Claims 1-3 and 6: Arunapuram discloses the use of a method for shipping items which can be from a first country to a second country (Paragraphs 0066 and 0068) comprising the steps:

- a. Fulfilling order in a first country, packaging the items in the first country and consolidating the individual packages for a collective international shipment (Paragraphs 0077 and 0081);
- b. Shipping the collective shipment to a second country (Paragraphs 0077 and 0081)
- c. Dividing the collective shipment in the second country into individual packages and delivering the packages to the customer (crossdock, paragraph 0077);

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- d. Providing a first shipping charge (Charge based on Total WD, weight distance, S1 + S2, Page 15, Arunapuram discloses that the rates are calculated for each leg of route as well as total, paragraph 0077);
 - e. Providing a second shipping charge related to a virtual supplier location (the examiner considers the cross dock, or the port in the US, to be the virtual location, therefore the second charge would be the charge associated with the second leg of the route, S2);
 - f. Computing a difference between the first and second charges (Arunapuram discloses getting the ratios of each leg, and where the rates are associated with each ratio, Paragraphs 0138 and 0140); and
 - g. Utilizing the computer difference to manage shipping charge information (Paragraphs 0141 and 0148).
12. With respect to Claim 4: Arunapuram discloses utilizing weights to calculate rates, using rate tables (Paragraph 0104).
13. With respect to Claim 5: Arunapuram discloses utilizing zone rating for calculation of rates with in the US, which is the second country (Paragraphs 102 and 109).
14. With respect to Claims 8 and 9: Arunapuram discloses the first charge includes shipping individual packages within the 2nd country and includes the charge for shipping the collective shipment from the first country to the second country (the examiner considers the first charge to be the total charge, which would include all charges, for each route leg, Paragraphs 0077, and page 15, Total WD).

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15. With respect to Claim 10: Arunapuram discloses that computing the second shipping charge comprising using a table for zone rating (Paragraphs 104 and 109).

16. With respect to Claim 11: Arunapuram discloses the calculating of the second shipping charge includes weight information (All rates calculated are based on weight, Paragraphs 0038, 0065 and 0104).

17. With respect to Claim 12: Arunapuram discloses the calculation of the second charge uses both weight and distance, which if shipped in the US, carriers such as UPS, use zones, instead of strait distance, therefore uses weight and zones (Paragraphs 102, 109)

18. With respect to Claim 13: Arunapuram discloses processing multiple order is optimization batches (Paragraph 0039). The examiner considers this to be carrying out the steps for a related time period, then repeating the steps for successive time periods.

19. With respect to Claim 17: Arunapuram discloses setting the second charges without referencing the first charge (each leg is calculated on its own, therefore the first charge references the second charge not the other way around, see Paragraphs 0066, 0071 and 0077).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arunapuram et al. (US 2002/0019759).

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22. With respect to Claim 7: Arunapuram, as disclosed above, discloses multiple legs of the route being determined, and shipped using a shipping entity, however fails to disclose the entities which ship the consolidated shipment and the entities which ship the individual shipments are the same entity. This limitation is deemed to be non-functional descriptive material nonfunctional and is not functionally involved in the steps recited. The shipping steps would be performed the same regardless of what entity is actually carrying the shipment. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Arunapuram, to have the shipping entities be the same for the entire route, in order to simplify the freight movement, so there does not have to be any coordination of different entities.

Response to Arguments

23. With respect to the previously made 101 rejection: This rejection has been dropped.

24. With respect to the previous 112 2nd paragraph rejection all previously made rejections have been dropped, and the examiner has entered in new 112 2nd paragraph rejections, the previous rejections pointed to the fact that the claims were indefinite due to the fact that they do not recite how the computer differences were utilized. This rejection has been rewritten above. The applicant gives reasons how the shipping charges are managed, however these limitations do not appear in the claim. Due to the fact that the preamble of the claim states a method for

managing shipping charges, the actual steps of how this is done, is considered to be essential steps needed to perform and understand the claimed method. See rejection above.

25. With respect to Applicant's arguments with regards to the American Gas reference: This rejection no longer stands in the office action, therefore arguments are moot.

26. With respect to Applicant's arguments that Arunapuram does not embody the motivation for the claimed invention: Applicant is claiming a method, including a series of steps, as outlined above, the examiner considers Arunapuram to disclose the claimed steps. The fact that Arunapuram does not embody the motivation for the claimed invention is irrelevant, the steps are the same, therefore the method is the same, the reason for using a method or the motivation for using a claimed invention is not considered to be patentable subject matter, only the method itself, therefore argument found unpersuasive.

27. With respect to Applicant's arguments that Applicant do not find a teaching or suggestion in Arunapuram for computing, and managing shipping charges as claimed: The examiner has more clearly pointed out above, where the cited reference contains the claimed limitations. The examiner considers Arunapuram to disclose each of the claimed limitations, therefore rejection stands as stated above.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wojcik et al. (5,666,493) discloses the use of an ordering system, which consolidates shipments overseas, ships the consolidated shipment, then disassembles the shipment in the receiving country, Pool et al. (US 2005/0021366) discloses the use of a universal shopping tool

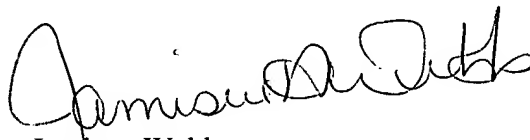
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for international shopping, and Monelcone et al. (US 2002/0046310 discloses the use of an order entry system over the internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb
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AU 3629